DOCKET NO. P05411 **PATENT**
CLIENT NO. NATI15-05411
Customer No. 23990

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Moshe Alon
Serial No.:	10/797,478
Filed:	March 10, 2004
For:	CLOCK FREQUENCY MONITOR
Group No.:	2816
Examiner:	An T. Luu

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal. The review is requested for the reason(s) stated in the arguments below, demonstrating the clear legal and factual deficiency of the rejections of some or all claims.

Claims 1-10 and 15-24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Admitted Prior Art ("*APA*") in view of U.S. Patent No. 6,289,055 to Knotz ("*Knotz*"). Claims 11-14 and 25-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *APA* and *Knotz* in further view of U.S. Patent No. 6,542,013 to Volk et al. ("*Volk*").These rejections are legally and factually deficient in that various claim limitations are not found in the art at all, Examiner Luu misstates the teachings of the art, and there is no proper motivation to combine these references.

APA recites a circuit having a reference clock counter 22, a high frequency clock counter 24, and a single comparator 27. Examiner Luu acknowledges that *APA* fails to disclose "at least two comparators," each of which is operative "to compare [a] pulse count with a respective given threshold value and to output a corresponding indication of frequency deviation", as required by Claims 1 and 15, but alleges that *Knotz* discloses these elements and that it would be obvious to modify *APA* with *Knotz*. Examiner Luu is incorrect.

Each of the comparators 31-3n of *Knotz* simply generates an output by comparing a voltage of the multilevel signal *m* to a reference voltage. However, the outputs of the comparators 31-3n in no way represent an "indication of frequency deviation." As clearly shown in Figure 3 of *Knotz*, the different reference voltages of *Knotz* simply represent possible voltage levels within the multilevel signal *m*. The different reference voltages of *Knotz* are not used in any way to indicate a "frequency deviation" of a signal. As a result, *Knotz* fails to disclose, teach, or suggest "at least two comparators," each of which is operative "to compare [a] pulse count with a respective given threshold value and to output a corresponding indication of frequency deviation" as recited in Claims 1 and 15. As such, Examiner Luu's rejection is both legally and factually deficient.

The comparators 31-3n of *Knotz* are used for a purpose completely unrelated to any function of *APA*. The comparators 31-3n of *Knotz* are specifically used to allow multiple digital signals to be summed and transmitted over a single lead. The comparators 31-3n of *Knotz* must be used in order for the multiple digital signals to be recovered from the multilevel signal *m* at the receiver 3. This functionality is not needed in *APA* in any way. The high frequency clock counter 24 of *APA* outputs a single value to the comparator 27. *APA* never recites that the high frequency clock counter 24 needs to simultaneously output multiple values over a single lead. As a result, there is no need to incorporate the comparators 31-3n of *Knotz* into the system of *APA*.

Examiner Luu's response indicates that the Examiner misunderstands the teachings of *Knotz* clearly teaches in col. 3, lines 24-32 that the comparators function to provide an amplitude filtering of the multilevel signal m. As can be seen, the signals s_{31}, s_{32}, . . . s_{3n} are the result of an amplitude filtering – also illustrated clearly in *Knotz* Figure 3 – and have nothing to do with an "indication of frequency deviation." Examiner Luu's statements to the contrary are factually incorrect, and illustrate the factual deficiency of the rejection.

Volk also fails to teach or suggest the relevant limitations of the independent and dependent claims.

Examiner Luu also states, incorrectly and without basis, that "figure 3 of Knotz clearly indicates a frequency that a reference signal (i.e., signal m) is above a first threshold V1 (i.e. signal S31) and a frequency that a reference signal is above a second threshold V2 (i.e. signal SC'). Therefore, the outputs of the comparators indicate changes of the frequency of the input signal with respect to predetermined values V1 and V2" (page 6, second paragraph of final Office Action).

Signal m is amplitude filtered, and the voltage thresholds are not at all compared with the frequency of signal m. Examiner Luu evidently confuses amplitude and frequency in *Knotz*'s teachings, and has unable or unwilling to clarify this reasoning. The rejection is legally and factually deficient.

The "motivation" alleged by the Examiner is "since it would provide different readings in at the same moment" (page 3, second paragraph of final Office Action). The Examiner acknowledges that "[t]he combination of prior arts is based on general knowledge, and not based on Applicant's disclosure" (page 6, first paragraph). Clearly, there is also no such motivation taught in *Knotz*, and the law is clear that the motivation to combine or modify must be specific to the actual teachings sought to be combined. "When the references are in the same field as that of the applicant's invention, knowledge thereof is presumed. However, the test of whether it would have been obvious to select specific teachings and combine them as did the applicant must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention." (*In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998), emphasis added). As Examiner Luu's "general knowledge" statement of motivation is does not teach making any specific modification at all, this rejection is legally deficient.

The Examiner seeks to combine the references by combining *Knotz*'s dual-comparator amplitude filter and use it in the circuit as disclosed in *APA*. Nothing in the cited art, or in the knowledge of those of skill in the art, suggests that adding an amplitude filter to the *APA* circuit would have any utility whatsoever. Nothing of "general knowledge", as alleged by the Examiner, would suggest looking to *Knotz*'s amplitude filter for any purpose in the *APA* circuit.

Although Applicant has challenged Examiner Luu's factual assertion as not properly officially noticed or not properly based upon common knowledge, Examiner Luu has refused to support the finding with adequate evidence as required by MPEP 2144.03.

As described above, Examiner Luu's rejections of all claims are both legally and factually deficient, and it would therefore be inappropriate to put the Applicant to the time and expense of an appeal at this time.

CONCLUSION

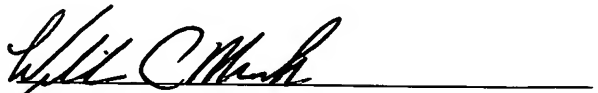
As a result of the foregoing, the Applicant asserts that the claims in the Application are in condition for allowance over all art of record, and respectfully requests this case be returned to the Examiner for allowance or, alternatively, further examination.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS P.C.

Date: May 30, 2006



William A. Munck
Registration No. 39,308

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: *wmunck@munckbutrus.com*